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**OFFICE OF PETITIONS**

In re Patent No. 7,244,584 : DECISION ON REQUEST FOR  
Zuker et al. : RECONSIDERATION OF  
Issue Date: July 17, 2007 : PATENT TERM ADJUSTMENT  
Application No. 09/510,332 : and  
Filed: February 22, 2000 : NOTICE OF INTENT TO ISSUE  
Attorney Docket No. 02307E- : CERTIFICATE OF CORRECTION  
098010US(20000452) :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)," filed July 13, 2007. The instant petition is being treated under 37 C.F.R. §1.705(d). No petition pursuant to §1.705(b) may be filed after payment of the Issue Fee. In this case, the Issue Fee was paid on September 2, 2004. Patentees request that the patent term adjustment of four hundred (400) days indicated on the Determination of Patent Term Adjustment Under 35 U.S.C. 154(b) be increased to nine hundred twenty-two (922) days.

The request for reconsideration of the patent term adjustment under § 1.705(d) is **GRANTED to the extent indicated herein.**

For the reasons stated herein, the patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of eight hundred forty-eight (848) days.

Patentees are given **TWO (2) MONTHS** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

On July 17, 2007, application No. 09/510,332 matured into Patent No. 7,244,584. The instant request for reconsideration filed July 13, 2007, in response to the Issue Notification, was timely filed within 2 months of the date the patent issued. See § 1.705(d). The Patent issued with a revised Patent Term Adjustment of 400 days. Patentees argue that an error in the determination is due, in part, to the Patent Office's erroneous treatment of two granted *Petitions Under 37 C.F.R. §1.181(a) to Withdraw Holdings of Abandonment as Petitions to Revive*.

Patentees' arguments have been considered, as follows:

Patentees request a further period of adjustment of 1177 (284 + 48 + 845) days for the Office failing to respond to a reply under 35 U.S.C. 132 not later than four months after the date on which the reply was filed. A response was filed on June 18, 2002. Patentees argue that pursuant to the decision to withdraw the holding of abandonment mailed July 25, 2003, an Office action was first mailed to the proper correspondence address of record on July 29, 2003. Accordingly, patentees argue entitlement to an additional period of adjustment of 284 days (i.e. October 19, 2002 to July 29, 2003). Patentees are correct. A period of adjustment of 284 days has been entered.

Patentees further argue that a response to the Office action mailed July 29, 2003 was filed on January 22, 2004 and that a period of adjustment of 48 days should be entered because the Office did not take action until the mailing of a corrected Notice of Allowance on June 9, 2004. A review of the application history reveals that a response was filed on January 26, 2004. In this regard, patentees' attention is directed to 37 CFR 1.703(f), which provides that "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. See also, Comment 10, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000). Accordingly, the date of receipt of January 26, 2004, not the certificate of mail date of January 22, 2004, is properly used in calculating patent term adjustment. Moreover, a Notice of Allowance was mailed on April 8, 2004. This was within four months. Accordingly, no period

of adjustment was entered. The mailing of a corrected Notice of Allowance does not negate the fact that a Notice of Allowance was mailed on April 8, 2004 and properly considered in calculating Office delay.

However, patentees are correct that the entry of a period of reduction of 411 days in association with patentees' response filed January 26, 2004 is incorrect. Applicant delay pursuant to 37 CFR 1.704(b) for the applicant taking in excess of three months to file a response is properly calculated using the date of re-mailing of the Office action, July 29, 2003, not the date of the original mailing, September 11, 2002. Accordingly, the period of reduction is 89 days, not 85 days or 411 days (i.e., October 30, 2003 to January 26, 2004, not January 22, 2004).

Patentee requests that an additional 845 days of PTO delay occurred after payment of the issue fee. It is noted that the instant application for patent term adjustment was filed prior to issuance of the patent. At issuance of the patent, 919 additional days were entered for the Office taking in excess of four months to issue the patent after payment of the issue fee. Thus, to the extent that patentees request entry of a period of adjustment for Office delay in issuing the patent after payment of the issue fee, the application for patent term adjustment is moot.

However, this period was calculated as from January 10, 2005 to July 17, 2007. As the issue fee was actually paid (and replacement drawings submitted) on September 2, 2004, this period should have been calculated from the date beginning on the day after four month from payment of the issue fee and satisfaction of all outstanding requirements, January 3, 2005, to the date of issuance of the patent, July 17, 2007. Accordingly, a period of adjustment of 7 days is being entered for the period beginning on January 3rd and ending on January 9th.

Moreover, it is noted that a period of adjustment of 104 days was entered for the Office taking in excess of three years to issue the patent. With respect to \$1.703(b), it is noted that the patent issued three years and 1023 days after its filing date. However, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap, with the days of patent term adjustment accorded prior to the issuance of the patent will not

result in any additional patent term adjustment. Further, in considering the overlap, the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). See 35 U.S.C. 154(b)(1)(B); 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f). In this instance, it was properly concluded that the period of 919 days overlapped. Thus, the application accrued 104 additional days pursuant to 37 CFR 1.703(b). However, given the entry of an additional period of adjustment of 284 days, which overlaps with the 1023 days, the application should not accrue any additional days pursuant to 37 CFR 1.703(b). Accordingly, the period of adjustment of 104 days pursuant to 37 CFR 1.703(b) is being removed.

A review of the application history further reveals that a period of reduction of 120 days was entered pursuant to 37 CFR 1.704(c)(10) for applicant filing drawings after the mailing of the Notice of Allowance. This is in connection with drawings filed November 22, 2004. It is noted that this was a resubmission of the drawings filed September 2, 2004. Nonetheless, entry of the period of reduction of 120 days is warranted. 37 CFR § 1.704(c)(10) provides that:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

Other than those papers identified in this Notice, all papers filed after allowance of an application substantially delay the Office's ability to process an application for a patent because the Office does not wait until payment of the Issue Fee to begin the patent issue process. As a result, 37 CFR 1.704(c)(10) does

not distinguish between papers that are and are not required by the Office. Filing of any drawings after allowance will be treated as a failure to engage in reasonable efforts to conclude prosecution. See *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance*, 1247 OG 111 (June 26, 2001; See also MPEP 2700. In this instance, drawings were filed on September 2, 2004 along with a petition to accept color drawings. The Office took action in response on April 27, 2007. Accordingly, a period of reduction of 120 days was properly entered, but for the lesser period (as opposed to from September 2, 2004 to April 27, 2007) associated with the drawings filed September 2, 2004.

Moreover, a review of the application history reveals that further drawings were filed on May 18, 2007 and the patent issued on July 17, 2007. Pursuant to 37 CFR 1.704(c)(10), a further period of reduction of 61 days is being entered for the period beginning on May 18, 2007 and ending on July 17, 2007.

It is noted that patentees did not delay in filing petitions to withdraw the holding of abandonment as appropriate. Accordingly, no periods of reduction pursuant to 37 CFR 1.704(c)(4) were entered for applicant failure to file a petition to withdraw the holding of abandonment or to revive an application within two months from the mailing date of a notice of abandonment.

Both patentees and the Office agree that a period of reduction of 92 days in association with the response filed June 18, 2002 was properly entered pursuant to 37 CFR 1.704(b).

Patentees are incorrect that a period of reduction should be entered for applicant taking in excess of three months to file a continued prosecution application (CPA) after the mailing of a non-final Office action on April 11, 2001. This application became eligible for patent term adjustment due to examination delay under 35 U.S.C. 154(b) by virtue of the filing of the CPA on September 27, 2001. Calculation of the patent term adjustment does not begin until the filing of the CPA on September 27, 2001.


In view thereof, the patent should have issued with a revised Patent Term Adjustment of eight hundred forty-eight (848) days.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) is eight hundred forty-eight **(848)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

Receipt is acknowledged of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by eight hundred forty-eight (848) days.

Telephone inquiries specific to this decision may be directed to the undersigned at (571) 272-3219.

  
Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosures: Copy of UPDATED Pair Screen  
Copy of DRAFT Certificate of Correction

Day : Monday  
Date: 11/19/2007

# **PALM INTRANET**

Time: 19:38:30

## **PTA Calculations for Application: 09/510332**

Application Filing Date:	02/22/2000	PTO Delay (PTO):	1023
Issue Date of Patent:	07/17/2007	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	623
Post-Issue Petitions:	0	Total PTA (days):	848
PTO Delay Adjustment:	448		

## **File Contents History**

Number	Date	Contents Description	PTO	APPL	START
122	11/19/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		61	
121	11/19/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		89	
120	11/19/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	411		
119	11/19/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		104	
118	11/19/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	284		
117	11/19/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	7		
112.5	06/27/2007	PTA 36 MONTHS	104		
112	07/17/2007	PATENT ISSUE DATE USED IN PTA CALCULATION	919		82
111	05/17/2007	SEQUENCE FORWARDED TO PUBS ON TAPE			
110	06/01/2007	WORKFLOW - QUERY REQUEST - FINISH			
109	05/25/2007	EXPORT TO INITIAL DATA CAPTURE			
108	04/27/2007	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
107	04/26/2007	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
106	04/27/2007	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
105	04/26/2007	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
104	04/11/2007	WORKFLOW - QUERY REQUEST - BEGIN			
103	04/02/2007	RECEIPT INTO PUBS			
102	04/02/2007	RECEIPT INTO PUBS			
101	04/02/2007	RECEIPT INTO PUBS			
100	04/02/2007	RECEIPT INTO PUBS			
99	03/29/2007	DISPATCH TO FDC			
98	03/29/2007	DISPATCH TO FDC			

97	03/29/2007	DISPATCH TO FDC			
96	03/29/2007	DISPATCH TO FDC			
95	11/22/2004	WORKFLOW - DRAWINGS FINISHED		120	106
94	09/02/2004	ISSUE FEE PAYMENT VERIFIED			
93	03/29/2007	DISPATCH TO FDC			
92	03/29/2007	DISPATCH TO FDC			
91	03/29/2007	DISPATCH TO FDC			
90	03/29/2007	DISPATCH TO FDC			
89	03/29/2007	CORRESPONDENCE ADDRESS CHANGE			
88	03/29/2007	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
87	03/29/2007	RECEIPT INTO PUBS			
86	12/12/2006	RECEIPT INTO PUBS			
85	12/12/2006	RECEIPT INTO PUBS			
84	12/12/2006	RECEIPT INTO PUBS			
83	12/12/2006	APPLICATION IS CONSIDERED READY FOR ISSUE			
82	09/09/2004	ISSUE FEE PAYMENT VERIFIED			
81	12/11/2006	WITHDRAW PUBLICATION/PRE-EXAM ABANDON			
80	12/12/2006	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
79	11/17/2006	MAIL-PETITION DECISION - GRANTED			
78	11/22/2004	PETITION ENTERED			
77	09/02/2004	PETITION ENTERED			
76	11/22/2004	NEW OR ADDITIONAL DRAWING FILED		0	
74	10/21/2004	MAIL ABANDONMENT FOR FAILURE TO CORRECT DRAWINGS/OATH			
73	10/21/2004	ABANDONMENT FOR FAILURE TO CORRECT DRAWINGS/OATH/NONPUB REQUEST			
72	10/19/2004	RECEIPT INTO PUBS			
71	09/02/2004	WORKFLOW INCOMING AMENDMENT IFW			
70	09/02/2004	ISSUE FEE PAYMENT RECEIVED			
69	07/16/2004	RECEIPT INTO PUBS			
68	06/23/2004	RECEIPT INTO PUBS			
67	06/09/2004	MAIL CORRECTED NOTICE OF ALLOWANCE			
66	06/08/2004	CORRECTED NOTICE OF ALLOWANCE			
65	06/08/2004	CORRESPONDENCE ADDRESS CHANGE			
64	05/10/2004	SEQUENCE FORWARDED TO PUBS ON TAPE			



63	04/30/2004	RECEIPT INTO PUBS			
62	04/29/2004	WORKFLOW - FILE SENT TO CONTRACTOR			
61	04/23/2004	MAIL CORRECTED NOTICE OF ALLOWANCE			
60	04/23/2004	CORRECTED NOTICE OF ALLOWANCE			
59	04/08/2004	MAIL NOTICE OF ALLOWANCE			
58	04/08/2004	MAIL FORMAL DRAWINGS REQUIRED			
57	04/08/2004	MAIL EXAMINER'S AMENDMENT			
56	04/08/2004	ISSUE REVISION COMPLETED			
55	04/08/2004	FORMAL DRAWINGS REQUIRED			
54	04/08/2004	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
53	04/08/2004	CASE DOCKETED TO EXAMINER IN GAU			
52	04/08/2004	EXAMINER'S AMENDMENT COMMUNICATION			
51	04/08/2004	NOTICE OF ALLOWABILITY			
50	02/12/2004	CORRESPONDENCE ADDRESS CHANGE			
49	02/12/2004	DATE FORWARDED TO EXAMINER			
48	01/26/2004	RESPONSE AFTER NON-FINAL ACTION		411	34
47	01/26/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
46	07/29/2003	RESTART RESPONSE OF ACTION			
45	07/29/2003	MAIL NOTICE OF RESTARTED RESPONSE PERIOD			
44	07/29/2003	LETTER RESTARTING PERIOD FOR RESPONSE (I.E. LETTER RE: REFERENCES)			
43	07/29/2003	MAIL NOTICE OF RESCINDED ABANDONMENT			
42	07/29/2003	NOTICE OF RESCINDED ABANDONMENT IN TCS			
41	07/25/2003	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
40	04/28/2003	PETITION ENTERED			
39	04/23/2003	MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
38	04/23/2003	ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
37	03/17/2003	POWER TO MAKE COPIES AND/OR INSPECT			
36	03/18/2003	CORRESPONDENCE ADDRESS CHANGE			
35	03/18/2003	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
34	09/11/2002	MAIL NON-FINAL REJECTION			
33	09/09/2002	NON-FINAL REJECTION			

32	07/02/2002	DATE FORWARDED TO EXAMINER			
31	06/18/2002	RESPONSE TO ELECTION / RESTRICTION FILED		92	29
30	06/18/2002	REQUEST FOR EXTENSION OF TIME - GRANTED			
29	12/18/2001	MAIL RESTRICTION REQUIREMENT			
28	12/17/2001	REQUIREMENT FOR RESTRICTION / ELECTION			
27	10/04/2001	CORRESPONDENCE ADDRESS CHANGE			
26	09/27/2001	PRELIMINARY AMENDMENT			
25	10/04/2001	DATE FORWARDED TO EXAMINER			
24	09/27/2001	CONTINUING PROSECUTION APPLICATION - CONTINUATION (ACPA)			
23	09/27/2001	MAIL EXPRESS ABANDONMENT (DURING EXAMINATION)			
22	09/27/2001	EXPRESS ABANDONMENT (DURING EXAMINATION)			
21	09/27/2001	WORKFLOW - REQUEST FOR CPA - FINISH			
20	09/27/2001	REQUEST FOR EXTENSION OF TIME - GRANTED			
19	09/27/2001	WORKFLOW - REQUEST FOR CPA - BEGIN			

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#### EXPLANATION OF PTA CALCULATION

#### EXPLANATION OF PTE CALCULATION

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UNITED STATES PATENT AND TRADEMARK OFFICE  
**CERTIFICATE OF CORRECTION**

PATENT : 7,244,584 B2

DATED : July 17, 2007

INVENTOR(S) : Zuker et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (400) days

Delete the phrase "by 400 days" and insert – by 848 days--